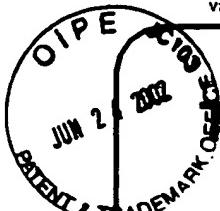


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Application Number	09/394,019
Filing Date	September 10, 1999
First Named Inventor	Akira Komoriya
Group Art Unit	1653
Examiner Name	Robinson, P.
Total Number of Pages in This Submission	300-903830US

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

TECH CENTER 1600, 2900

Firm or Individual name	Tom Hunter, Reg. No. 38,498, Quine Intellectual Property Law Group P.C.
Signature	
Date	June 17, 2002

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date: June 17, 2002

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TECH CENTER 1600/2900

In re application of:

**AKIRA KOMORIYA and BEVERLY
PACKARD**

Application No.: **09/394,019**

Filed: **09/10/1999**

For: **COMPOSITIONS FOR THE
DETECTION OF ENZYME ACTIVITY IN
BIOLOGICAL SAMPLES AND METHODS
OF USE THEREOF**

Examiner: Chih Min Kam

Art Unit: 1653

RESPONSE TO COMMUNICATION

Assistant Commissioner for Patents

Washington, D.C. 20231

Dear Sir:

This document is filed in response to the Communication (paper 24) mailed on May 15, 2002. In that communication, the Examiner alleged that the replay filed on April 30, 2002 is not fully responsive to the prior Office Action mailed November 21, 2001 (Paper No: 21) because Applicants did not elect one amino acid sequence, one fluorophore, and one hydrophobic group for the elected invention, Group I, claims 1-15.

Applicants note that the Examiner's election of species fails to comply with the requirements of such an election as set forth in MPEP §809.02(a) which states:

Action as follows should be taken:

- (A) Identify generic claims or indicate that no generic claims are present. See MPEP § 806.04(d) for definition of a generic claim.
- (B) Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, to which claims are restricted. **The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively.** In the absence of

distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species cannot be conveniently identified, the claims may be grouped in accordance with the species to which they are restricted. [emphasis added]

In the instant case, the Examiner has failed to indicate which claim(s) are generic or to indicate that no generic claims are present. In addition, the Examiner has failed to specifically identify each of the species. Moreover, the particular material, or other distinguishing characteristic of the species has not been stated for each species identified. Indeed, from the Office Action, Applicants cannot ascertain what constitutes a species in the Examiner's opinion, or even how many species are present.

For example, it is unclear whether the Examiner requires an election of a sequence from claim 1, pertaining to particular "P" domains or an election of a sequence from claim 4.

Nevertheless in the interest of compact prosecution, in response to this restriction requirement, Applicants elect s a species within Group I comprising:

- 1) The amino acid sequence: KDPJGLEHDGINGJPKGY (SEQ ID NO:248);
- 2) The fluorophore 9-(2,5 (or 2,6)-dicarboxyphenyl)-3,6-bisamino-xanthylium halide or other anion (Rh110) (item 5 in the Markush Group of claim 9); and
- 3) The hydrophobic group: 9-fluoreneacetyl group (item 2 in the Markush Group of claim 12).

With respect to the listing of claims readable on the elected species, Applicants note that claim 1 is generic and claim 1 and dependent claims 2-12 and 15 are readable on the elected species.

Applicants understand that upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. §1.141.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 337-7871.

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Respectfully submitted,



Tom Hunter
Reg. No: 38,498